

REMARKS

In the Office Action dated September 22, 2006, the Examiner (1) rejected claims 32-41 under 35 U.S.C. § 101 as directed to non-statutory subject matter; (2) rejected claims 1, 8, 11-13, 18-24, 27, 29, 32, 33, and 37-38 under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 6,317,718 to Fano ("Fano"); (3) rejected claim 2 under 35 U.S.C. § 103(a) as unpatentable over Fano in view of an Official Notice; (4) rejected claims 3-5 under 35 U.S.C. § 103(a) as unpatentable over Fano in view of U.S. Patent Application Publication No. 2004/0215524 to Parkyn ("Parkyn"); (5) rejected claims 6, 7, 9, 34, 35, 39, and 40 under 35 U.S.C. § 103(a) as unpatentable over Fano in view of U.S. Patent No. 6,937,998 to Schwartz et al. ("Schwartz"); (6) rejected claims 10, 14, 15, 25, 28, 30, 36, and 41 U.S.C. § 103(a) as unpatentable over Fano in view of U.S. Patent Application Publication No. 2002/0194081 to Perkowski ("Perkowski"); (7) rejected claims 16, 17, 26, and 30 under 35 U.S.C. § 103(a) as unpatentable over Fano in view of U.S. Patent Application Publication No. 2003/0027555 to Malackowski et al. ("Malackowski"), and (8) rejected claim 31 under 35 U.S.C. § 103(a) as unpatentable over Fano in view of U.S. Patent No. 6,386,450 to Ogasawara ("Ogasawara").

In this Amendment, Applicant amends claims 1, 4, 7, and 10-12, 14-21, and 23-26 to improve form. Applicant also cancels claims 2, 3, 5, 6, 8, 9, 13, 22, and 27-41 without prejudice or disclaimer. Applicant adds new claims 42-49. No new matter has been added.

1. Rejection of Claims 32-41 Under § 101

Although Applicant disagrees with the Examiner's rejection of claims 32-41 under § 101, this rejection is moot because Applicant has canceled these claims.

2. Rejection of Claims 1, 8, 11-13, 18-24, 27, 29, 32, 33, and 37-38 Under § 102(b)

The Examiner rejected claims 1, 8, 11-13, 18-24, 27, 29, 32, 33, and 37-38 under § 102(b) as anticipated by U.S. Patent No. 6,317,718 to Fano. Applicant canceled claims 8, 13, 22, 27, 29, 32, 33, and 37-38, rendering the rejection of these claims moot. Claims 1, 11-12, 18-21, and 23-26 remain rejected. Applicant respectfully traverses these rejections.

A proper rejection under § 102(b) requires that a single reference teach every aspect of the claimed invention either explicitly or inherently. See M.P.E.P. § 2131. Applicant respectfully submits that Fano does not disclose the combination of features recited in claims 1, 11-12, 18-21, and 23-26 at least for the reasons discussed below.

Amended claim 1 recites:

1. A method comprising:
determining whether a portable device is or is not located within a first site;
wherein when the portable device is located within the first site:
sending a menu of items located at the first site to the portable device for displaying to a user,
receiving, from the portable device, a selection by the user of at least one item from the menu of items located at the first site, and
sending location information regarding the at least one item selected from the menu of items at the first site to the portable device for displaying to the user; and
wherein when the portable device is not located within the first site:
sending to the portable device a menu of sites located within a vicinity of the portable device for displaying to the user, and

receiving from the portable device a selection of a second site from the menu of sites by the user.

Fano does not disclose or suggest this combination. For example, Fano does not disclose or suggest “determining whether a portable device is or is not located within a first site,” as recited in claim 1. This feature is similar to a feature previously recited in original claim 6, although amended claim 1 is of different scope than original claim 6. In rejecting claim 6, the Examiner relies on column 47, line 58, to column 48, line 26, for allegedly disclosing “determining whether the portable device is located at a particular site.” See Office Action at 10. Applicant submits that neither this section nor any other section of Fano discloses determining whether a portable device is or is not located within a first site, as recited in amended claim 1. At column 47, line 56, to column 48, line 26, Fano discloses:

Browsing

To address the need of many shoppers to visit malls or shop generally without a particular destination in mind. FIG. 27 illustrates a display in accordance with a preferred embodiment of the invention. The display operates in a browse mode for use by shoppers as they stroll through the mall. In browse mode the system suggests items of interest for sale in the stores currently closest to the shopper. An item is considered to be of interest if it matches the categories entered in the goals screen. If there are no items of interest, the general type of merchandise sold at that store is displayed, rather than specific items. As the shopper strolls a map displays his or her precise current location in

the mall. If an item displayed is selected by the shopper while browsing, the system alerts the shopper to the local retailer offering the same product for the lowest price, or announces the best local price. This search is restricted to the local mall, as that is the assumed radius the shopper is willing to travel.

This section of Fano discloses “the system suggest[ing] items of interest for sale in the stores currently closest to the shopper.” Col. 47, line 57, to col. 48, line 26 (emphasis added). This section of Fano also discloses displaying “the general type of merchandise” of stores currently closest to the shopper, if the store does not have “items of interest.” Fano, however, does not disclose or suggest determining whether a portable device is or is not located within a first site, as also required by claim 1.

Further, with respect to claim 6, the Examiner asserts:

The Examiner notes that the system determines whether a user is at a particular site/store by determining if the store has items of interest to the user and displaying a menu of those items of interest. Additionally, when the server determines that the portable device is not located at the particular site (i.e. the store does not have items of interest), it displays stores in the vicinity of the portable device along with the merchandise they offer.

Office Action at 10. The Examiner appears to equate a store not having items of interest, as taught in Fano, with the portable device not being located within a site, as claimed in claim 1. Applicant respectfully disagrees with the Examiner. Whether or not a store has an item of interest, as taught in Fano, cannot be equated with whether a portable device is

or is not located within a site because the portable device could be located within a site while the site has “no items of interest,” which the Examiner believes corresponds to the portable device not being located within a site.

Since Fano does not disclose or suggest determining whether a portable device is or is not located within a first site, as required by claim 1, Fano also cannot disclose or suggest: (1) sending a menu of items located at the first site to the portable device when the portable device is located within the first site; or (2) sending to the portable device a menu of sites located within a vicinity of the portable device when the portable device is not located within the first site, as required by claim 1.

Thus, at least for the foregoing reasons, Applicant submits that claim 1 is not anticipated by Fano. Claim 11 depends on claim 1 and includes all the features of claim 1. Because Fano does not anticipate claim 1, it also cannot anticipate claim 11. Therefore, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of claims 1 and 11 under § 102(b) as anticipated by Fano.

Although amended independent claims 12 and 20 are of different scope than each other and claim 1, claims 12 and 20 include some similar features as claim 1. For example, claim 12 recites, among other things, “determine[ing] whether the portable device is or is not located within a first site.” Claim 20 recites, among other things, “determine[ing] whether a portable device is or is not located within a first site.” Thus, at least for similar reasons as claim 1, Applicant submits that claims 12 and 20 are not anticipated by Fano.

Claims 18, 19, 21, 23, and 24 depend on one of claim 12 or claim 20 and include all the features of their respective base claim. Because Fano does not anticipate claims

12 or 20, it also cannot anticipate claims 18, 19, 21, 23, and 24. Therefore, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of claims 18, 19, 21, 23, and 24 under § 102(b) as anticipated by Fano.

3. Rejection of Claim 2 Under § 103(a)

The Examiner rejected claim 2 under § 103(a) as unpatentable over Fano in view of an Official Notice. Applicant respectfully disagrees with the Examiner's Official Notice without citation to a reference. Nonetheless, this rejection is moot because Applicant has canceled claim 2.

4. Rejection of Claims 3-5 Under § 103(a)

The Examiner rejected claims 3-5 under § 103(a) as unpatentable over Fano in view of Parkyn. Applicant cancelled claims 3 and 5, rendering the rejection of these claims moot. Claim 4 remains rejected. This rejection is respectfully traversed, since a prima facie case of obviousness has not been made by the Examiner.

To establish a prima facie case of obviousness under §103(a), each of three requirements must be met. First, the reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. See M.P.E.P. §2143.03. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of these requirements must "be found in the prior art, and not be based on applicant's disclosure." M.P.E.P. §2143.

Claim 4 depends on claim 1 and includes all the features of claim 1. Parkyn does not cure the deficiencies of Fano described above with respect to claim 1. Parkyn

discloses a “vendor system, accessible via a cellular phone network, WiFi or wired network, that responds to purchase inquiries within iterative pricing.” See Abstract. However, neither Fano nor Parkyn, alone or in reasonable combination, discloses or suggests determining whether a portable device is or is not located within a first site, as required by claim 1.

Because neither Fano nor Parkyn, alone or in reasonable combination, discloses or suggests all the features of claim 4, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of claim 4 under § 103(a).

5. Rejection of Claims 6, 7, 9, 34, 35, 39, and 40 Under § 103(a)

The Examiner rejected claims 6, 7, 9, 34, 35, 39, and 40 under § 103(a) as unpatentable over Fano in view of Schwartz. Applicant cancels claims 6, 9, 34, 35, 39, and 40, rendering the rejection of these claims moot. Claims 7 remains rejected. This rejection is respectfully traversed, since a prima facie case of obviousness has not been made by the Examiner.

Claims 7 depends on claim 1 and includes all the features of claim 1. As discussed above, Fano does not disclose or suggest all the features of claim 1. Schwartz does not cure the deficiencies of Fano described above with respect to claim 1. Schwartz discloses a “portable terminal carried by a user and in wireless communication with a local area network for displaying data based on the physical location of the user.” See Abstract. Schwartz also discloses a “base station[] located in a common area . . . for general information gathering processes.” Col. 9, lines 38-41.

Neither Fano nor Schwartz, however, alone or in reasonable combination, discloses or suggests determining whether a portable device is or is not located within a first site, as required by claim 1. Because neither Fano nor Schwartz, alone or in reasonable combination, discloses or suggests all the features of claim 7, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of claim 7 under § 103(a).

6. Rejection of Claims 10, 14, 15, 25, 28, 30, 36, and 41 Under § 103(a)

The Examiner rejected claims 10, 14, 15, 25, 28, 30, 36, and 41 U.S.C. § 103(a) as unpatentable over Fano in view Perkowski. Applicant cancelled claims 28, 30, 36, and 41, rendering the rejection of these claims moot. Claims 10, 14, 15, and 25 remain rejected. These rejections are respectfully traversed, since a prima facie case of obviousness has not been made by the Examiner.

Claims 10, 14, 15, and 25 depend on independent claims 1, 12, or 20 and include all the features of their respective base claim. As discussed above, Fano does not disclose or suggest all the features of independent claim 1, 12, or 20. Perkowski does not cure the deficiencies of Fano described above with respect to claim 1. Perkowski discloses an internet-based consumer service to carry out service-related functions along the demand side of a retail chain. See Abstract. Despite the 302 pages of disclosure (including 126 sheets of drawings and 256 columns of text), Applicant cannot find any disclosure in Perkowski that discloses or suggests, for example, determining whether a portable device is or is not located within a first site, as required by claims 10, 14, 15, and 25.

Because neither Fano nor Perkowski, alone or in reasonable combination, discloses or suggests all the features of claims 10, 14, 15, or 25, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of claims 10, 14, 15, and 25 under § 103(a).

7. Rejection of Claims 16, 17, 26, and 30 Under § 103(a)

The Examiner rejected claims 16, 17, 26, and 30 under § 103(a) as unpatentable over Fano in view of Malackowski. Applicant cancelled claim 30, rendering the rejection of these claims moot. Claims 16, 17, and 26 remain rejected. These rejections are respectfully traversed, since a prima facie case of obviousness has not been made by the Examiner.

Claims 16, 17, and 26 depend on one of independent claims 12 or 20 and include all the features of their respective base claim. As discussed above, Fano does not disclose or suggest all the features of claims 12 or 20. Malackowski does not cure the deficiencies of Fano. For example, neither Fano nor Malackowski, alone or in reasonable combination, discloses or suggests determining whether a portable device is or is not located within a first site as required by claims 16, 17, and 26.

Because neither Fano nor Malackowski, alone or in reasonable combination, discloses or suggests all the features of claims 16, 17, or 26, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of claims 16, 17, and 26 under § 103(a).

8. Rejection of Claim 31 under § 103(a)

The Examiner rejected claim 31 under § 103(a) as unpatentable over Fano in view of Ogasawara. Although Applicant disagrees with the Examiner's rejection, the rejection is moot because Applicant cancelled this claim.

9. New Claims 42-50

Applicant submits that new claims 42-49 are allowable over the cited art. Claims 42-44 depend on one of independent claims 1, 12, or 20 and, therefore, are patentable over the cited art at least for the reasons given above.

Although independent claims 45 and 48 are of a different scope than each other and claim 1, both claims include some similar features found in claim 1 and, thus, are patentable over the cited art for at least similar reasons as claim 1. Claims 46-47 and 49 depend on one of independent claims 45 or 48 and are patentable over the prior art for at least the same reasons as their respective base claims.

The Office Action dated September 22, 2006, contains certain characterizations of the invention, the application claims, and the prior art with which Applicant does not necessarily agree. Unless expressly noted otherwise, Applicant declines to subscribe to any statement or characterization made in the Office Action. In particular Applicant's remarks with respect to independent claims are sufficient to overcome the Examiner's rejections of all claims dependent thereon. Applicant's silence as to the Examiner's assertions with respect to dependent claims is not a concession by Applicant to the Examiner's assertions as to those claims, and Applicant reserves the right to analyze and dispute such assertions in the future.

In view of the foregoing amendments and remarks, Applicant respectfully requests the Examiner's reconsideration of this application, and the timely allowance of the pending claims.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-1070 and please credit any excess fees to such deposit account.

Respectfully submitted,

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Date: February 20, 2007

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